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10/729,468	12/06/2003	Thomas E. Chefalas	YOR920030571US1	1252
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IBM CORPORATION, T.J. WATSON RESEARCH CENTER			MEJA, ANTHONY	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/729,468	<b>Applicant(s)</b> CHEFALAS ET AL.
	<b>Examiner</b> Anthony Mejia	<b>Art Unit</b> 4117

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 December 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Specification***

1. The use of the trademarks WINDOWS®, MICROSOFT OUTLOOK® and LOTUS® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.
  
2. The specification is objected to as failing to provide clear support or antecedent basis for the claimed subject matter. See 37 CFR 1.75(d) (1) and MPEP § 608.01(o). The meaning of every term and expressions used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import. In this case, the terms "selected items" used in claims 1, 8 and 15 are not apparent from the descriptive portion of the specification with clear disclosure as to its import. For the purposes of further examination, the term "selected items" will be interpreted as being synonymous with selecting an operating system, application programs thereof, that are needed to create the desired user configuration, with the term used elsewhere in the specification. Appropriate correction is required.

***Claim Objections***

3. Claims 1 and 15 objected to because of the following informalities: lack of antecedent basis in the claims. In this case, claims 1 and 15 recites, "from said set of backup copies", however, in the previous limitation within the claims recites, "set of backup non-specific copies". For the purposes of examination the recitation of "from said set of backup copies" will be interpreted as "from said set of backup non-specific copies". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
5. Claims 2-7, and 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In this case, for example claim 2, reciting the term "said software means" is vague and/or ambiguous in that it raises uncertainty as to whether the claim is referring to the "said software means" for storing the parameters of said user configuration or the "said software means" for restoring said user configuration by copying selected items

from said set of backup copies to said user computer in accordance with the parameters of said user configuration, recited in claim 1. For the purposes of examination, the examiner will interpret the recitation of "said software means" as being either one of the "said software means" recited on claim 1. Appropriate correction is required. See MPEP § 608.01(m))

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1 and 8 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

In this case, for example claim 1, seems to be directed to a "computer system" comprising a server and a user computer, the computer system [AS BEST UNDERSTOOD] further comprising, "said software means", basically software. The claimed "computer system", raises uncertainties as to whether this is an attempt to claim a machine or a series of machines. In accordance with the specification [page 4, lines 5-6], the user computer and the server are separate machines, as such the "computer system" claimed, can not reasonably in light of the written disclosure be considered/treated as a machine, and hence, does not fall under the eligible patentably category subject matters, i.e. process, machine, manufacturer, composition of matter or material and improvements thereof (see MPEP § 2106). Claims 2-7 and 9-14 are also

rejected to at least for inheriting the informalities of claims 1 and 8 through their dependency.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3, 6, 8, 10, 13, 15, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sedlack et al. (US 2004/0025155) (referred herein after as Sedlack) in further view of Collins et al. (2004/0243998) (referred herein after as Collins).

Regarding Claim 1, Sedlack, in a similar field of endeavor, such as a system for configuring a software image for installation into a computer system, discloses a computer system comprising

a server (400 of fig. 4d) and at least one user computer (100 of fig. 4d) having a user configuration of a user operating system and at least one application program (forming software image 152) (par 0045), further comprising:

software means (402 of fig. 4d) for storing the parameters (152) of said user configuration (e.g. program (402) causes image (152) to be stored onto the server

(400), see par 0051));

However, Sedlack does not explicitly disclose a set of backup non-specific copies stored in a portion of said system other than said user computer, of a set of operating systems, including said user operating system, and a set of application programs, including said at least one application program.

Collins, in a similar field of endeavor such as restoring an information handling system to a previous software state, discloses a set of backup non-specific copies stored in a portion of said system other than said user computer (e.g. download server, 220 of fig. 2) of a set of operating systems, including said user operating system, and a set of application programs, including said at least one application program (e.g., has copies of ALL operating system versions, drivers, application software, and BIOS versions used by factory, par [0019]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Sedlack's invention with Collins, in order to have a default copy of different types of operating systems and application programs, to satisfy the desirability of Sedlack's desire of being able to configure a system to a user's desire, using it's original default settings. One of ordinary skill of the art at that time the invention was made, would have been motivated to combine the teachings of Sedlack and Collins to allow a user in being able to recover default settings of all operating system versions or application programs.

In further, Sedlack discloses a software means (402 of fig. 4d) for restoring said user configuration to said user computer (100 of fig. 4d) in accordance with the

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parameters of said user configuration (152) (par [0051]). Sedlack does not disclose wherein restoring is by copying selected items from said set of non-specific backup copies.

However, Collins, discloses wherein restoring is by copying selected items from said set of non-specific backup copies (e.g., has copies of ALL operating system versions, drivers, application software, and BIOS versions used by factory, par [0019]). Collins does not disclose restoring said user configuration to said user computer in accordance with the parameters of said user configuration.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Sedlack and Collins to enable the restoring of an Operating System or application program to be applied to the user configuration as taught by Sedlack. One of ordinary skill of the art at that time the invention was made, would have been motivated to combine the teachings of Sedlack and Collins, to be able to enable a user in being able to restore the default settings of all operating systems and application programs if desired by the user.

Regarding Claims 3, 10, and 17 the combined teaching of Sedlack/Collins further teach wherein said software means (402 of fig. 4d) records user choices during a parameter specifying process before the installation of said user configuration (e.g., user configures software (e.g., operating system, applications, and data) to a desired state, and records user choices (e.g., forms image of operating system, applications, and data choices of user) that will be uploaded to the server for the installation of a

computer system) [see Sedlack: par 0043-0044].

Regarding Claims 6, 13, and 20 the combined teachings of Sedlack further discloses in which said software means (backup procedure/script) further comprises means for recording modifications to said user configuration ([see Sedlack: par 0043-0044] ).

Regarding Claim 8, the combined teachings of Sedlack/Collins, disclose a computer system comprising

a server (Sedlack: 400 of fig. 4b) and at least one user computer (Sedlack: 100 of fig. 4b) having a user configuration of a user operating system and at least one application program (Sedlack: forming software image 152) (Sedlack: par 0045), further comprising:

software means (Sedlack: 402 of fig.4d) for storing the parameters (152) of said user configuration (Sedlack: program (402) causes image (152) to be stored onto the server (400), par 0051);

means for accessing (logs on) a set of backup non-specific copies stored outside said system (Collins: download server, 220), of a set of operating systems, including said user operating system, and a set of application programs, including said at least one application program (Collins: e.g., has copies of ALL operating system versions, drivers, application software, and BIOS versions used by factory, par [0019]).

Regarding Claims 15, the combined teachings of Sedlack/Collins suggest the combination of the steps set forth above of in claim 1, wherein Sedlack discloses the respective steps of software means stored on a computer readable medium (e.g., floppy disk, CD-ROM), (par [0048]).

Therefore, it would have been obvious to store the combination of software means on an article of manufacturer to be able to execute the automatic image of installation on any computer that contains a device that is able to read and implement an article of manufacturer. One ordinary skill in the art would appreciate having the capability of being able to perform these instructions from an article of manufacturer to be help optimize the accessibility of being able to automatically re-configure multiple systems to their desired image.

10. Claims 4, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sedlack in view of Collins in further view of Richard (US 2001/0056425).

Regarding Claim 4, 11, and 18 the combined teachings of Sedlack and Collins discloses a system described in claim 1 above.

The combined teachings of Sedlack and Collins do not disclose in which said software means examines the parameters of an existing user configuration.

However, Richard, in a similar field of endeavor such as an automatic backup and recovery process, discloses in which a software means (backup procedure/script)

examines the parameters of an existing user configuration (e.g., systematic analysis of the different elements of the configuration), (par [0009]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Richard in Sedlack/Collins in order to analyze the parameters of an existing configuration to make a comparison with the configuration that a user had before the modification or error occurred. One of ordinary skill at the time the invention was made would have been motivated to combine the teachings of Sedlack/Collins and Richard to help optimization of a configuration recovery process on a system.

7. Claims 2, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sedlack in view of Collins, and in further view of Bergman et al. (US 2005/0028144) (referred herein after as Bergman).

Regarding Claims 2, 9 and 16, the combined teachings of Sedlack/Collins does not explicitly disclose in which said software means monitors user choices during an installation process installing said user configuration.

However, Bergman, similar field of endeavor, such as systems and methods for generating and distributing executable procedures, discloses in which said software means (e.g., monitoring application) monitors user choices (e.g., actions) during an installation process installing said user configuration (e.g., execution trace), (par [0009-0010]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Sedlack/Collins with Bergman to be able to monitor user configuration choices during an installation process to be able to build accurate user images. One of ordinary skill of the art at that time the invention was made, would have been motivated to combine the teachings of Sedlack/Collins and Bergman to help enable users to have the advantage of being able to configure their systems to their own original individual installation configurations and to have the ability to easily upgrade the systems when necessary.

7. Claims 5, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sedlack in view of Collins, and Bergman an in further view of Richard.

Regarding Claims 5, 12, and 19, the combined teachings of Sedlack/Collins/Berman does not disclose in which said software means further comprises means for recording incremental changes to said user configuration.

However, Richard discloses in which software means (backup procedure/script) further comprises means for recording incremental changes (incremental process) to said user configuration (col.3, lines 8-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Sedlack/Collins/Berman with Bergman in order to identify the parameters that have been changed since the last recovery process was performed. One of ordinary skill of the art would have been motivated to combine

the teachings of Sedlack/Collins/Berman and Richard to minimize the amount of data needed for a recovery process on a user system.

8. Claims 7, 14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sedlack in view of Collins and Richard, and in further view of Shirriff (US 2002/0198968) (referred herein after as Shirriff).

Regarding Claim 7, 14 and 21 the combined teachings of Sedlack/Collins/Richard system does not explicitly disclose in which said software means further comprises means for re-examining the parameters of said existing user configuration and recording modifications thereto.

However, Shirriff, in a similar field of endeavor, such as a method and apparatus for automatic configuration of a cluster of computers, discloses in which said software means (e.g., browser, 138, communicates with the scripts and configurers) further comprises means for re-examining (verifies) the parameters of said existing user (e.g., administrator) configuration and recording modifications thereto (e.g., configuration) (par [0018 and 0040]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of the Sedlack/Collins/Richard system with Shirriff, in order to verify the existing user configuration and making a record of this configuration. One of ordinary skill of the art at the time the invention was made would have been motivated to combine the teachings of Sedlack/Collins/Richard and Shirriff to

increase the reliability of the user configurations that are implemented and to reassure their functionalities.

***Other Pertinent Prior Art***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Boxall et al. (US 2003/0046678) discloses a computer hardware and software installation apparatus and method.

B. Johnson et al. (US 5,923,885) discloses an acquisition and operation of remotely loaded software using applet modification of browser software.

C. Joory (US 2002/0026436) discloses a system for supplanting application setup data and preserving the application set up data that has been supplanted.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Mejia whose telephone number is 571-270-3630. The examiner can normally be reached on Mon-Thur 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beatriz Prieto can be reached on 571-272-3902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mejia, Anthony  
Patent Examiner

/Prieto, Beatriz/

Supervisory Patent Examiner, Art Unit 4117